

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q60742

Nicolas BROGNE, et al.

Appln. No.: 09/667,779

Group Art Unit: 2151

Confirmation No.: 1269

Examiner: Khanh Q. DINH

Filed: September 22, 2000

For: A METHOD OF MANIPULATING AN ALREADY SENT E-MAIL AND
CORRESPONDING SERVER

REPLY BRIEF UNDER 37 CFR §41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant submits the following:

ARGUMENT

As described in appellant's initial brief, the problem to which the present invention is directed is how to allow a sender of an email to retract or modify an email that has been sent to a plurality of recipients. One of the goals sought by the present invention, as described in the specification, is to not have the recipient know that a sender has modified or sought to modify the email after sending it. Thus, as described at lines 11-26 of page 9 of the specification, on receiving a request by the sender to modify a message, the email server allows the modification if the message has not yet been accessed by any of the addressees, and if it has been accessed by any of the addressees the modification request is denied. And in order to ensure that the recipient does not know about the modification, all of this takes place at a server that operates independently of the email processing systems of any of the addressees.

Beginning at line 26 of column 16, Nielsen clearly describes that, when a modification request is received from the sender after an email has been accessed by a recipient, the sender is permitted to modify the email, and the recipient is notified. As described repeatedly in Nielsen, e.g., at lines 9-11 of column 16, the server storing the email and processing the modification request is part of the recipient's email system. Again, directly contrary to the present invention.

Both of these requirements of the invention are clearly recited in independent claims 1, 3, 10 and 11, and these distinctions were pointed out in appellant's Brief.

In the Examiner's Answer, the examiner has responded to the first point of distinction by arguing that Nielsen permits a recipient to delete an email after reading it, and if the recipient does this, no one will thereafter be able to modify the email, and then arguing that this satisfies

the language of the appealed claims. While this is an interesting proposal, it is contrary to common sense and contrary to what is described and claimed in the present application.

A first problem is that the examiner's proposed interpretation of the claim language is based on the premise that deleting an email does not constitute "modifying" the email in the context of the present claims. But claim 2 explicitly states that modification of said email comprises deleting said email body or modifying a part of the email body. Thus, even according to the example given by the examiner, when an addressee accesses the email and thereafter deletes it, the addressee has violated the requirement of claim 1 that no addressee is permitted to modify the email after any addressee has accessed the email.

A second problem with the examiner's position is that, even with the incorrect interpretation of the claim language, the claim is not taught by the prior art. More particularly, claim 1 describes a method wherein (1) an email is sent by a sender to a plurality of addressees, (2) the email body is stored on a server that operates independently from any email processing means associated with each of the addressees, (3) a modification message sent by the sender of the email is sent to the independently operating server, (4) if the email body has not been accessed by any of the addressees, the email body is modified according to the message sent from the sender, and this modification occurs independently of any email processing means associated with each of the addressees, and (5) if the email body has been accessed by any of the addressees, the requested modification is denied.

With regard to (1), the example in Neilsen cited by the examiner in support of his rejection talks only of "the" recipient. There is no discussion of a circumstance where a message

addressed to a plurality of addressees is stored somewhere and then accessed by one of the group. Indeed, the examiner relies on the deletion by the recipient as the claimed “accessing,” but there is no suggestion that a recipient who is only one of many addressees could be permitted to delete the email if the others had not yet seen it. This simply points up the fact that Nielsen is directed to an entirely different type of system than what is described and claimed by appellant.

Further long this same line, it is an important feature of the invention that the email body is stored on a server that operates independently of the addressee email systems and that the handling of the modification is performed independently of the addressee email system. But Nielsen makes it very clear (e.g., lines 6-26 of column 16) that the email is stored in the recipient’s email system. The examiner has not addressed this issue. The examiner makes the point that the server and modification are independent of the *sender* email systems, but this is not what is claimed. What is claimed is that the server and modification must operate independently of any email processing means associated with each of the *addressees*. This is clearly not the case in Nielsen where the email is stored at the recipient’s email system and the modification is carried out in clear concert with the recipient’s email system (see, e.g., lines 26-49 of column 16 where it is described that the recipient’s email system notifies the recipient, offers several choices to the recipient, and responds to the recipient’s choices). What is happening in Nielsen is that the recipient is simply deleting his own copy of a received email. This is not what the present invention is about, and is not what is being claimed.

Still further, claim 1 recites that the email body is modified according to said modification message if the email body has not been accessed on the server by any of the

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addressees, and that *the* modification of said email body is denied if the email body has been accessed. The only antecedent basis for *the* modification is the earlier recitation in claim 1 of the modification according to said modification message that is sent by the sender. There is no suggestion in Nielsen of the concept of preventing the addressees from modifying an email in response to a modification message sent by the sender.

The remaining independent claims distinguish over the cited art for the same reasons as claim 1.

In sum, the reading of the examiner is clearly unsupportable, and even if adopted still does not result in satisfaction of the language of the appealed claims. Reversal of the examiner is therefore believed in order.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: August 13, 2007

/DJCushing/
David J. Cushing
Registration No. 28,703